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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte
TAKAYUKI USUI and TOSHIZI SONE

Appeal 2008-2128
Application 09/921,713
Technology Center 3700

Decided: June 30, 2008

Before TONI R. SCHEINER, LORA M. GREEN, and
RICHARD M. LEOVITZ, *Administrative Patent Judges*.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 8, 27, 30, 33, and 35-40, all the claims remaining in the application. The claims stand rejected as obvious over the prior art. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

DISCUSSION

The claimed invention is directed to a light-shielding packaging box for photosensitive printing plates. The box is designed to be inserted into an automatic plate making machine equipped with a printing plate automatic supplying apparatus (Spec. 5). The lid of the box can be opened and closed automatically by means of suction cups which engage a smooth, air-tight sheet-like material adhered to the outer surface of the lid of the box (Spec. 34-36; Fig. 6).

Claim 8 represents the invention in its broadest aspect, and reads as follows:

8. A printing plate packaging box comprising:
 - a box main body which accommodates a bundle of photosensitive printing plates, which are not sealed within a light-shielding wrapper, and which is provided with a supply opening through which the photosensitive printing plates are taken out, said photosensitive printing plates being in direct contact with said box main body;
 - an opening/closing lid which is removably attached to said box for opening/closing the supply opening; and
 - a light-shielding member which prevents direct entry of light from outside into the inside of the box main body, provided in the vicinity of a zone in which the box main body and the opening/closing lid are contacted to each other in an assembled state, the light-shielding member being connected to the opening/closing lid such that the light-shielding member blocks the direct entry of light from outside into the inside of the box through the zone in which the box main body and the opening/closing lid are contacted to each other in the assembled state, and said light-shielding member being circumferentially larger than said box main body such that said light-shielding member surrounds and covers an outermost portion of said box main body,
- wherein a sheet-type material of which surface is smooth and air tight is adhered onto an outer surface of said opening/closing lid.

Obviousness

The claims stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nowak (U.S. Patent 5,270,901, issued December 14, 1993) and Rosenblatt (U.S. Patent 3,483,965, issued December 16, 1969).

An invention “composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “Often, it will be necessary . . . to look to interrelated teachings of multiple [references] . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed[.]” *Id.* at 1740-41. “[T]his analysis should be made explicit” (*id.* at 1741), and it “can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” (*id.*).

Nowak describes a charge-dissipating packaging box for a stack of electrostatically active articles, such as lithographic printing plates (Nowak, col. 1, ll. 11-27). The box “includes a container portion, which defines a cavity for containing the articles and is conductive on all surfaces; and a nonconductive lid that fits over the container” (Nowak, col. 2, ll. 5-8). The nonconductive lid (31) is completely removable from the conductive container portion (Nowak, Fig. 2). According to the Examiner, Nowak discloses “all the limitations of the claim[s] except for a smooth sheet-type material adhered to the outer surface of said opening/closing lid” of the box (Ans. 4).

Rosenblatt describes “a method for covering objects, particularly books, with heat-shrinkable plastic film” to provide a “smooth taut dust cover” (Rosenblatt, col. 1, ll. 14-34). Double-sided adhesive tape is applied to the peripheral edges of a book binding. “The film can [then] be applied to the book in either of two ways. First, a flat sheet of plastic film slightly larger than the surface of the book . . . can be applied to the book by laying the book thereon. Second, the book can be inserted into a tube of plastic film” (Rosenblatt, col. 2, ll. 20-25). Then, “the book is exposed to heat sufficient to shrink the film to a smooth taut cover” (Rosenblatt, col. 2, ll. 29-31).

The Examiner contends that “it would have been obvious to one of ordinary skill in the art . . . to provide a sheet-type material of which surface is smooth and air tight to the opening/closing lid of Nowak . . . to provide a smooth taut dust cover” (Ans. 4).

Appellants argue essentially that one of skill in the art would not have perceived a need to protect the contents of Nowak’s charge-dissipating box from dust and wear with a cover of shrink wrap plastic film, and in any case,

the cover of Rosenblatt is not intended to be removed when the book is used. Accordingly, it is not even clear how such a cover would be applied to Nowak[‘s] [box] or how Nowak[‘s] [box] would be operable when saddled with the cover of Rosenblatt. In other words, a skilled artisan would not provide a heat-shrink material to the container of Nowak . . . because Nowak would essentially be rendered inoperable if such heat-shrink material were applied in the manner taught by Rosenblatt (i.e., Nowak would not open as intended).
(App. Br. 11-12).

Appellants have the better argument. Even if we accept, for the sake of argument, that one of skill in the art would have perceived a need to

protect the outer surfaces and/or the contents of Nowak's charge-dissipating box from dust and wear in the manner disclosed by Rosenblatt, the Examiner has not explained why one would cover only the lid of the box. If, on the other hand, one were to shrink wrap both the nonconductive lid of the box and the fully conductive lower container of the box, the lid of the box would not be removable, as required by the present claims. We agree with Appellants that the Examiner has not established that one of ordinary skill in the art would have had a reason to combine the references relied on in the manner claimed.

Accordingly, we reverse the Examiner's rejection of claims 8, 27, 30, 33, and 35-40 under 35 U.S.C. § 103(a) as obvious over the combined teachings of Nowak and Rosenblatt.

REVERSED

clj

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